

## **REMARKS**

Claims 1-18, 37-42, 44-51, and 53-55 are pending in the application. By this Amendment, claims 1, 10, 37, 45, and 47 have been amended for clarity and claims 19-36, 43, 52, and 56-68 have been cancelled. Exemplary support for the claim amendments can be found throughout the specification and claims as originally filed. See, for example, page 8, paragraph [0023], page 9, paragraph [0030], page 16, paragraph [0057] of the present specification.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

### **Claim Objections**

Claims 1-68 have been objected to because claims 1, 10, 19, 29, 37, 47, 56, and 63 recite the phrase "having a D50 between about" which is allegedly unclear. As claims 19, 29, 56, and 63 have been cancelled, the objection to these claims is moot. In order to expedite prosecution, claims 1, 10, 37, and 47 have been amended to replace "D50" with "mean diameter" as suggested by the Examiner at page 2 of the Office Action. Accordingly, Applicants respectfully submit that the objection to the claims should be withdrawn.

### **Rejection under 35 U.S.C. § 112**

Claims 43 and 52 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Without

conceding the propriety of the rejection and merely in order to expedite prosecution, claims 43 and 52 have been cancelled. Accordingly, this rejection is moot.

**Rejection under 35 U.S.C. § 103**

Claims 1-68 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over WO 02/012144 (hereinafter "Zuber") in view of U.S. Patent No. 5,336,318 (hereinafter "Attard"). As claims 19-36, 43, 52, and 56-68 have been cancelled, the rejection of these claims is moot. The rejection of the pending claims is respectfully traversed in view of the foregoing amendments.

The Office has the initial burden of establishing a **factual basis** to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

Zuber discloses a system comprising a gypsum board, a skim coating, and a jointing material, wherein the coating formulation and the jointing material formulation included cellulosic compounds. (Page 10, lines 7-19 and Page 15 lines 10 to 19).

Applicants respectfully submit that cellulosic compounds have two mutually non-exclusive functions as - (i) a thickening agent, and (ii) a water retention agent.

The present claims recite a jointing material which comprises a thickener and a water retention agent. As noted at page 16, paragraph [0057] of the present specification, the thickener and water retention agent are preferably a cellulosic compound or a mixture of cellulosic compounds. Accordingly, the presently recited jointing material can include cellulosic compounds. Generally, the jointing material contains a water retention agent such as a cellulosic compound because the presence of water provides a suitable viscosity such that the jointing material may be applied by any desirable means to effect assembly of the drywall elements. (See page 15, paragraph [0051] of the present specification). It should be noted that the present invention is not limited to the disclosed embodiment. Accordingly, the thickening and water retaining properties of the cellulosic compounds are desirable in the jointing material.

However, with regard to the skim coat, Applicants respectfully submit that cellulosic compounds may render the skim coat viscous and thus difficult to handle and during drying of the skim coat blisters may be formed due to the retention of water by the cellulosic compounds thus rendering the skim coat uneven and ineffective.

Applicants respectfully submit that the present disclosure provides a replacement for cellulosic compounds in the skim coat with other compounds such as polyacrylates that will avoid the problems discussed hereinabove. In this regard, Applicants respectfully submit that the present claims recite a skim coating comprising a polymeric noncellulosic thickener, wherein **the polymeric noncellulosic thickener is a polyacrylate**. It should be noted that polyacrylates exhibit desirable advantages over cellulosic compounds in skim coats because

polyacrylates are thickeners but not water retention agents. Applicants respectfully submit that the use of polyacrylates versus cellulosic compounds in the skim coat is desirable because the lack of retention of water by the polyacrylates in comparison with cellulosic compounds not only significantly reduces the formation of blisters on the skim coat but also accelerates drying of the skim coat.

Applicants respectfully submit that the cited references do not disclose or suggest that cellulosic compounds in the skim coat should be replaced with polyacrylates. While it is noted that Zuber discloses acrylic acid esters in the skim coat, Zuber also discloses cellulosic ether as being a required component of the skim coat. (See page 18, lines 9-16). In this regard, Applicants respectfully submit Zuber merely discloses acrylic acid esters (*i.e.*, salts of acrylic acid) that are simple organic compounds. In contrast, the present claims recite a noncellulosic thickener polyacrylate, which is a polymer. Applicants respectfully submit that one of ordinary skill in the art will appreciate that simple organic compounds are significantly different from polymers. Accordingly, it is respectfully submitted that Zuber does not disclose or suggest the presently recited polyacrylates. Moreover, it should be noted that Zuber not only fails to disclose or suggest polyacrylates in the skim coat, but Zuber also fails to appreciate the advantages (refer to discussion hereinabove) of polyacrylates in skim coats. Zuber further fails to appreciate the disadvantages (refer to discussion hereinabove) resulting from the presence of cellulosic compounds in the skim coat.

It is further respectfully submitted that the pending claims do not recite that the skim coat and the jointing material have the same composition. Accordingly, Applicants respectfully disagree with the Examiner's position that the skim coat and

the jointing material have the same composition. (Office Action, Pages 12-13). As noted above, cellulosic compounds may be used in the presently recited jointing material but the skim coat does not include cellulosic compounds.

Further, with regard to the Examiner's position regarding the presently recited weight percentages (Office Action, Pages 6-8), Applicants respectfully submit that specifically recited weight percentages are not mere "design choices". In this regard, the Examiner's attention is directed to M.P.E.P. § 2144.04 wherein it is provided that the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. See In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Applicants respectfully submit that In re Kuhle did not relate to specifically recited weight percentages but instead related to the placement of a contact in a conductivity measuring device. Accordingly, it is respectfully submitted that the presently recited weight percentages are not obvious either over the hand-waving argument of design choice or over the cited references.

Attard has been cited merely as disclosing the jointing material can include polymeric noncellulosic thickeners. Applicants respectfully submit that Attard, as cited, fails to cure the many above-noted deficiencies of Zuber. Accordingly, Zuber and Attard, either alone or in combination, fail to disclose or suggest the features recited in the pending claims.

In light of at least the foregoing, Applicants respectfully submit that the obviousness rejection should be withdrawn.

**Conclusion**

Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

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